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MAILED

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OFFICE OF PETITIONS

In re Application of :
Mitchell R. Swartz :
Application No. 09/750,480 :
Filed: December 28, 2000 :
Attorney Docket No. :

ON PETITION

This is in response to the petition under 37 CFR 1.181, filed September 13, 2006, , which is being treated as a petition to withdraw the holding of abandonment of the above identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be submitted within **two (2) months** from the mail date of this decision and be entitled "Renewed Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181." *See* 37 CFR 1.181(f).

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of January 11, 2005. The reply to a final Office action must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

A petition under 37 CFR 1.181 was filed on April 8, 2005. This petition was denied by the Technology Center 3600 Director on May 10, 2005. This petition was the only response filed by applicant during the response time set in the final Office action.

A Notice of Abandonment was mailed September 5, 2006 which noted that no response had been received in reply to the Office letter mailed on "06 July 2005".

Petitioner argues that the abandonment was improper since he had never received an Office letter mailed July 6, 2005. A review of the file shows that, as indicated by petitioner, there is no Office letter or any other Office communication mailed on July 6, 2005.

However, petitioner's argument is not convincing of improper abandonment. Abandonment is a fact of law. The final Office action mailed January 11, 2005 was not properly responded to in a timely manner by applicant.

37 CFR 1.135 states:

§ 1.135 Abandonment for failure to reply within time period.

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Applicant failed to properly reply and thus the application was appropriately abandoned. The May 8, 2005 petition to the Technology Center 3600 Director was not an acceptable response to the final Office action since it was denied and thus the final Office action remained in effect.

A Notice of Abandonment (PTOL 1432) is a courtesy letter which informs applicant of the abandoned status of his application. While it is unfortunate that the examiner inserted an incorrect date for the final Office action on this form, the Notice was correct in indicating that the application was abandoned for failure to reply to an Office letter. In any event, this is a moot issue as this notice is not sent out until after an application is determined to be in abandoned status. The notice itself has no bearing on abandonment of an application.

Therefore, the petition to withdraw the holding of abandonment is **dismissed**.

ALTERNATIVE VENUE

Petitioner is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition under 37 CFR 1.181 or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR 1.111 or (B) a continuing application under 37 CFR 1.53(b).

- (2) The petition fee as set forth in 37 CFR 1.17(m), **\$810.00 for a small entity;**
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
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Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-6842.



Carl Friedman
Petitions Examiner
Office of Petitions